

ESTTA Tracking number: **ESTTA767417**

Filing date: **08/29/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

| | |
|---------------------------------------|--|
| Name | Mars, Incorporated |
| Granted to Date of previous extension | 08/28/2016 |
| Address | 6885 Elm Street McLean, VA 22101 UNITED STATES |
| Attorney information | Jason J. Mazur Arent Fox LLP 1717 K Street, NW Washington, DC 20006-5344 UNITED STATES jason.mazur@arentfox.com, tmdocket@arentfox.com, ross.panko@arentfox.com Phone:202-715-8409 |

Applicant Information

| | | | |
|------------------------|--|------------------------|------------|
| Application No | 86790434 | Publication date | 03/01/2016 |
| Opposition Filing Date | 08/29/2016 | Opposition Period Ends | 08/28/2016 |
| Applicant | Societe des Produits Nestle S.A. Intellectual Property Department Vevey, 1800 SWITZERLAND | | |

Goods/Services Affected by Opposition


Class 031. First Use: 0 First Use In Commerce: 0
All goods and services in the class are opposed, namely: Food for animals

Grounds for Opposition

| | |
|--------------------------------------|----------------------------|
| Priority and likelihood of confusion | Trademark Act Section 2(d) |
|--------------------------------------|----------------------------|

Marks Cited by Opposer as Basis for Opposition

| | | | |
|----------------------|--|-----------------------|------------|
| U.S. Application No. | 87098861 | Application Date | 07/11/2016 |
| Registration Date | NONE | Foreign Priority Date | NONE |
| Word Mark | MAX/SIMPLE. WHOLESOME. NUTRITION. /NUTRO /SINCE 1926 | | |

| | |
|---------------------|---|
| Design Mark |  |
| Description of Mark | The mark consists of Color is not claimed as a feature of the mark. The mark consists of a hexagonal shield design on product packaging, with the word MAX centered within the design. The words "SIMPLE. WHOLESOME. NUTRITION." are located below the word MAX. An oval design with stylized NUTRO is located centrally above the word MAX with "since 1926" placed on either side of the oval design. |
| Goods/Services | Class 031. First use: First Use: 2012/01/31 First Use In Commerce: 2012/01/31 Pet food |

| | | | |
|------------------------------------|---|------------------|------|
| U.S. Application/ Registration No. | NONE | Application Date | NONE |
| Registration Date | NONE | | |
| Word Mark | Trade dress rights in a hexagonal shield design as applied to Opposer's product packaging as set forth in the Notice of Opposition. | | |
| Goods/Services | Pet food | | |

| | |
|-------------|---|
| Attachments | 87098861#TMSN.png(bytes) Mars v. Nestle - Notice of Opposition (Hexagon Design).pdf(548538 bytes) |
|-------------|---|

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

| | |
|-----------|------------------|
| Signature | /Jason J. Mazur/ |
| Name | Jason J. Mazur |
| Date | 08/29/2016 |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application No. 86/790434, filed October 16, 2015, and published March 1, 2016.

| | | |
|----------------------------------|---|----------------------|
| MARS, INCORPORATED, |) | |
| |) | |
| Opposer, |) | |
| |) | |
| v. |) | Opposition No. _____ |
| |) | |
| SOCIETE DES PRODUITS NESTLE S.A. |) | |
| |) | |
| Applicant. |) | |
| _____ |) | |

NOTICE OF OPPOSITION

Mars, Incorporated (“Opposer”), a corporation duly organized and existing under the laws of the State of Delaware, having a place of business at 6885 Elm Street, McLean, Virginia 22101, believes that it will be damaged by the registration of the mark shown in Application Serial No. 86/790434, and hereby opposes the same under the provisions of Section 13 of the Trademark Act of 1946, 15 U.S.C. § 1063.

As grounds for opposition, Opposer alleges the following:

1. Opposer owns all right, title, and interest in and to a distinctive composite word and design mark shown below (“Opposer’s Mark”) that features a hexagonal shield design as a prominent and integral element.



2. Opposer has filed application Serial No. 87/098861 for Opposer’s Mark for “pet food” in Class 31 claiming first use and first use in commerce dates of January 31, 2012.

Attached hereto is a printout from the USPTO's online TESS database evidencing the existence of this application.

3. Opposer's Mark is used on packaging for Opposer's pet food and on materials advertising and promoting Opposer's pet food.

4. Opposer also owns trade dress rights in the hexagonal shield design in the proportion, size, and location in which it is applied to Opposer's product packaging ("Opposer's Trade Dress").

5. Opposer uses Opposer's Trade Dress consistently and uniformly across an entire line of pet food products—wet and dry food for dogs. As such, Opposer's Trade Dress functions as a source indicator for Opposer's products.

6. Representative examples showing the use of Opposer's Mark and Opposer's Trade Dress is below:

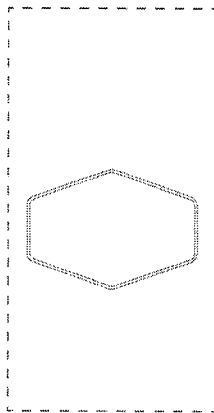


7. Opposer has used Opposer's Mark and Opposer's Trade Dress in interstate commerce since at least as early as January 31, 2012 on and in connection with pet food.

8. Opposer has extensively used, advertised, and promoted Opposer's Mark and Opposer's Trade Dress in interstate commerce in connection with Opposer's pet food goods.

9. As a result of such extensive use, advertising, and promotion, Opposer's Mark and Opposer's Trade Dress have become distinctive indicators of the origin of Opposer's goods and a valuable symbol of Opposer's goodwill.

10. Notwithstanding Opposer's prior use of and rights in Opposer's Mark and Opposer's Trade Dress, Applicant Societe des Produits Nestle S.A. ("Applicant") filed U.S. application Serial No. 86/790434 ("Applicant's Application") on October 16, 2015 for the mark shown below ("Applicant's Mark") for "food for animals" in Class 31.



11. In Applicant's Application, Applicant described Applicant's Mark as follows: "The mark consists of a hexagonal shield design on product packaging. The dashed outline represents the environment in which the mark is used and is not claimed as part of the mark."

12. The shape of the hexagonal shield design in Applicant's Mark is identical or virtually identical to the shape of the hexagonal shield design that is featured as a prominent and integral element in Opposer's Mark and that is contained in Opposer's Trade Dress.

13. The proportion, size, and location of the hexagonal shield design on the product packaging environment shown in the drawing of Applicant's Mark is identical or virtually identical to the proportion, size, and location of the hexagonal shield design contained in Opposer's Trade Dress.

14. Upon information and belief, when Applicant filed Applicant's Application, Applicant knew or had reason to know of Opposer's prior rights in Opposer's Mark and Opposer's Trade Dress, the use of the hexagonal shield design therein, and the manner of use on and as applied to Opposer's product packaging.

15. Applicant should not be entitled to unrestricted federal registration of a mark that is comprised of the same design element that Opposer previously adopted and used in an identical or virtually identical manner for the identical goods.

16. Opposer obtained extensions of time to oppose Applicant's Application through Sunday, August 28, 2016.

Likelihood of Confusion – §2(d)

17. The mark that Applicant seeks to register so closely resembles Opposer's Mark and Opposer's Trade Dress that the use and registration thereof is likely to cause confusion, mistake, and deception as to the source or origin of Applicant's goods and will injure and damage Opposer and the goodwill and reputation symbolized by Opposer's Mark and Opposer's Trade Dress.

18. Applicant's goods are similar or identical to Opposer's goods such that the public is likely to be confused, to be deceived, and to assume erroneously that Applicant's goods are those of Opposer, or that Applicant is in some way connected or affiliated with, or approved or sponsored by, Opposer, all to Opposer's irreparable damage.

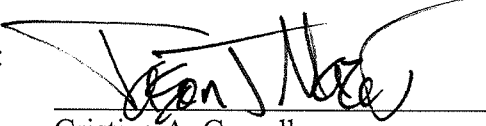
19. Likelihood of confusion is enhanced by the well-known character of Opposer's Mark and Opposer's Trade Dress and by the fact that consumers associate these marks with goods sold, approved, or endorsed by Opposer.

20. Likelihood of confusion is enhanced by the fact that purchasers of Applicant's goods are purchasers or prospective purchasers of Opposer's goods, and vice-versa.

21. Likelihood of confusion is enhanced by the fact that the goods at issue travel in the same channels of trade.

WHEREFORE, Opposer prays that the Board sustain this opposition and deny registration of the mark identified in Applicant's Application.

Dated: August 29, 2016

MARS, INCORPORATED
By: 
Cristina A. Carvalho
Jason J. Mazur
Ross Q. Panko
Arent Fox LLP
1717 K Street, N.W.
Washington, D.C. 20006
(202) 857-6000

*Attorneys for Opposer
Mars, Incorporated*

CERTIFICATE OF SERVICE

It is hereby certified that the foregoing **NOTICE OF OPPOSITION** (re: Serial. No. 86/790434) has been served on Applicant's Attorney of Record at the following address as listed in U.S. Patent and Trademark Office records by first class mail, postage prepaid, this 29th day of August, 2016.

Andrea K. Cannon
Nestle Purina Petcare Company
Checkerboard Square
Saint Louis, MO 63164-0001





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| | |
|------------------------------|--|
| Word Mark | MAX/SIMPLE. WHOLESOME. NUTRITION. /NUTRO /SINCE 1926 |
| Goods and Services | IC 031. US 001 046. G & S: Pet food. FIRST USE: 20120131. FIRST USE IN COMMERCE: 20120131 |
| Mark Drawing Code | (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS |
| Design Search Code | 26.03.01 - Ovals as carriers and single line borders 26.15.02 - Plain single or multiple line polygons; Polygons (plain, single line) |
| Serial Number | 87098861 |
| Filing Date | July 11, 2016 |
| Current Basis | 1A |
| Original Filing Basis | 1A |
| Owner | (APPLICANT) Mars, Incorporated CORPORATION DELAWARE Mars Incorporated 6885 Elm Street McLean VIRGINIA 221013883 |
| Attorney of Record | Courtney A. Laginess |
| Prior Registrations | 1810994;3579075;3679781 |
| Description of Mark | Color is not claimed as a feature of the mark. The mark consists of Color is not claimed as a feature of the mark. The mark consists of a hexagonal shield design on product packaging, with the word MAX centered within the design. The words "SIMPLE. WHOLESOME. NUTRITION." are located below the word MAX. An oval design with stylized NUTRO is located centrally above the word MAX with "since 1926" placed on either side of the oval design. |
| Type of Mark | TRADEMARK |
| Register | PRINCIPAL |

**Live/Dead
Indicator**

LIVE

TESS HOME

NEW USER

STRUCTURED

FREE FORM

BROWSE DICTIONARY

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